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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/554,633      | 10/25/2005  | Eugene Paul Wiltz Jr | 63562 US            | 9170             |

7590 06/10/2011  
Gary C Cohen  
1147 North Fourth Street  
Unit 6E  
Philadelphia, PA 19123

EXAMINER

COONEY, JOHN M

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

1765

| MAIL DATE | DELIVERY MODE |
|-----------|---------------|
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06/10/2011

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

|                              |                               |                                 |  |
|------------------------------|-------------------------------|---------------------------------|--|
| <b>Office Action Summary</b> | Application No.<br>10/554,633 | Applicant(s)<br>WILTZ JR ET AL. |  |
|                              | Examiner<br>JOHN COONEY       | Art Unit<br>1765                |  |

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 05 October 2010.
- 2a) ☐ This action is FINAL.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-6,9-12,15-21,24-27,29-31,33,34 and 36-38 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6,9-12,15-21,24-27,29-31,33,34 and 36-38 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>20101005</u> .  | 6) <input type="checkbox"/> Other: _____                          |

***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10-5-10 has been entered.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-6, 9-12, 15-21, 24-27, 29-31, 33, 34 and 36-38 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims are confusing as to intent because there is an apparent contradiction in claim 1 regarding the presence of A groups in the polyester polyol of the claims.

Claim 1 recites that group A4 is a part of the required A1, A2, A3, A4 groups of the listing of A groups, as opposed to A5 which is set apart as being optional. However, in reciting the amounts for A4, "up to 30 mole percent" is used which corresponds closely with the language used in describing the optional A5 group, "up to 7 mole percent". Claims are confusing as to intent because it can not be determined if A4 is intended to be a part of the required A groups or the optional A groups.

Claims 1-6, 9-12, 15-21, 24-27, 29-31, 33, 34 and 36-38 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims are confusing as to intent because it is not seen how the A groups A1, A2, A3, A4 and optionally A5 which constitute and define the make-up of the hydroxymethyl-containing polyester polyol set forth in the claims can be in the form of a "mixture". The claim language needs to be amended to clarify how the recited A groups are involved in the make-up of the claim components.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Cooney whose telephone number is 571-272-1070. The examiner can normally be reached on M-F from 9 to 6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck, can be reached on 571-272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/John Cooney/

Primary Examiner, Art Unit 1765

Receipt date: 10/05/2010

Doc code: IDS

Doc description: Information Disclosure Statement (IDS) Filed

PTO/SB/08a (01-10)

Approved for use through 07/31/2012. OMB 0651-0031

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| <b>INFORMATION DISCLOSURE<br/>STATEMENT BY APPLICANT</b><br>( Not for submission under 37 CFR 1.99) | Application Number     |            | 10554633   |  |
|   | Filing Date            |            | 2005-10-25 |  |
|   | First Named Inventor   | Wiltz, Jr. |            |  |
|   | Art Unit               | 1796       |            |  |
|   | Examiner Name          | Cooney     |            |  |
|   | Attorney Docket Number | 63562      |            |  |

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|  |                        |            |            |
|--|------------------------|------------|------------|
| <b>Receipt date: 10/05/2010</b><br><br><b>INFORMATION DISCLOSURE<br/>STATEMENT BY APPLICANT</b><br>( Not for submission under 37 CFR 1.99) | Application Number     |            | 10554633   |
|  | Filing Date            |            | 2005-10-25 |
|  | First Named Inventor   | Wiltz, Jr. |            |
|  | Art Unit               | 1796       |            |
|  | Examiner Name          | Cooney     |            |
|  | Attorney Docket Number | 63562      |            |

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| Examiner Signature   | /John Cooney/ |  | Date Considered | 06/07/2011               |
| *EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through a citation if not in conformance and not considered. Include copy of this form with next communication to applicant.  |               |  |                 |                          |
| <small> <sup>1</sup> See Kind Codes of USPTO Patent Documents at <a href="http://www.USPTO.GOV">www.USPTO.GOV</a> or MPEP 901.04. <sup>2</sup> Enter office that issued the document, by the two-letter code (WIPO Standard ST.3). <sup>3</sup> For Japanese patent documents, the indication of the year of the reign of the Emperor must precede the serial number of the patent document. <sup>4</sup> Kind of document by the appropriate symbols as indicated on the document under WIPO Standard ST.16 if possible. <sup>5</sup> Applicant is to place a check mark here if English language translation is attached.       </small> |               |  |                 |                          |

ALL REFERENCES CONSIDERED EXCEPT WHERE LINED THROUGH. /J.C./